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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,102	04/21/2000	Christopher T. Davey	BSC-134	6730

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EXAMINER

DESANTO, MATTHEW F

ART UNIT PAPER NUMBER

3763

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,102

Applicant(s)

DAVEY, CHRISTOPHER T.

Examiner

Matthew F DeSanto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11,12,17-25,30-38 and 42-45 is/are rejected.
- 7) ☒ Claim(s) 13-16,26-29 and 39-41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims 1-10, which are drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11, 12, 17, 18, 19, 20, 22, 23, 24, 25, 30, 31, 32, 34, 35, 36, 37, 38, 42, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann et al., and further in view of Yoon.

Hermann et al. (USPN 5599305). Hermann et al. discloses a proximal hub portion (36), an elongated body portion extending distally from the proximal hub portion (16, 18, 40), and a passageway extending through the proximal hub and elongated body portion, being defined by an inner surface of the sheath, and a valve (38) having a foam material filling at least some of the length of the passageway, the length of the foam material within the passageway being greater than the width of the foam material at any point within the passageway, (Fig. 3, Col 9, line 58 – Col 10, line 16) and one or

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more self-sealing slits in the foam material, where none of the slits extend in width to the inner surface of the sheath, and where the foam material is affixed to a portion of an inner surface of the sheath that defines the passageway, (Col. 9, line 41 – Col. 10, line 23). As in claim 17,18, wherein the elongated body portion comprises at least a first section, and a second section, where the first cross-sectional area is larger than the second cross-sectional area and further comprises a shoulder disposed within the passageway and between the first and second sections. The reference shows a first cross-sectional area starting after the valve (38), and then the shoulder (40), and then the second cross-sectional area (24). (Figure 2, and 3). As in claim 22, 34, 45 wherein the foam material comprises a closed cell foam. (Col 7, lines 19-58); but fail to disclose wherein the foam material fill at least some of the material of the passageway in the elongated body portion.

Yoon (USPN 6228068) discloses having a sheath with a valve, wherein the valve comprises a foam or compressible material and wherein the foam material extends the entire length of the sheath hub and elongated passageway. (Column 8, line 11 – Column 9, line 16 and Column 12, lines 33-54). Yoon discloses that since the compressible material or foam extends the entire length of the elongated body portion, it helps in stabilizing the trocar as well as helps in securing the trocar to the elongated body portion.

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine Hermann et al. with Yoon to obtain the claimed invention because,

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Yoon disclosed that using foam to line the elongated body helped in stabilizing and securing the trocar in relationship with the elongated body.

Therefore, it would have been obvious to combine Hermann et al. with Yoon to obtain the invention as specified in claims 11, 12, 17, 18, 19, 20, 22, 23, 24, 25, 30, 31, 32, 34, 35, 36, 37, 38, 42, 43 and 45.

3. Claims 11, 12, 17, 18, 19, 20, 22, 23, 24, 25, 30, 31, 32, 34, 35, 36, 37, 38, 42, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deem et al. (USPN 5104389), and further in view of Yoon.

Deem et al. discloses a sheath with a hub and an elongated body, wherein a foam valve is inserted into the hub and wherein the length of the foam material within the passageway being greater than the width of the foam material at any point within the passageway, and one or more self-sealing slits in the foam material, where none of the slits extend in width to the inner surface of the sheath, and where the foam material is affixed to a portion of an inner surface of the sheath that defines the passageway. As in claim 17, 18, wherein the elongated body portion comprises at least a first section, and a second section, where the first cross-sectional area is larger than the second cross-sectional area and further comprises a shoulder disposed within the passageway and between the first and second sections. The reference shows a first cross-sectional area starting after the valve, and then the shoulder, and then the second cross-sectional area. As in claim 22, 34, 45 wherein the foam material comprises a closed cell foam;

but fail to disclose wherein the foam material fill at least some of the material of the passageway in the elongated body portion.

Yoon (USPN 6228068) discloses having a sheath with a valve, wherein the valve comprises a foam or compressible material and wherein the foam material extends the entire length of the sheath hub and elongated passageway. (Column 8, line 11 – Column 9, line 16 and Column 12, lines 33-54). Yoon discloses that since the compressible material or foam extends the entire length of the elongated body portion, it helps in stabilizing the trocar as well as helps in securing the trocar to the elongated body portion.

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine Deem et al. with Yoon to obtain the claimed invention because, Yoon disclosed that using foam to line the elongated body helped in stabilizing and securing the trocar in relationship with the elongated body.

Therefore, it would have been obvious to combine Deem et al. with Yoon to obtain the invention as specified in claims 11, 12, 17, 18, 19, 20, 22, 23, 24, 25, 30, 31, 32, 34, 35, 36, 37, 38, 42, 43 and 45.e elongated body portion.

Allowable Subject Matter

4. Claims 13-16, 26-29, 39-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to claims 11, 25, and 36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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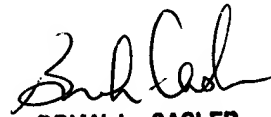
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1-703-308-0858.



Matthew DeSanto
Art Unit 3763
January 13, 2003



BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700